

REMARKS

Claims 21-38 are currently pending in the present application, with Claims 21 and 32 being in independent form. As indicated above, Claims 32 and 35-37 have been amended.

In the Office action mailed, the Examiner pursuant to 35 U.S.C. §121 and 37 CFR §1.142 required a restriction between:

- Group I: Claims 21-31, drawn to an apparatus, classified in class 347, subclass 2; and
- Group II: Claims 32-38, drawn to a system for remotely programming a vehicle control system, classified in class 101, subclass 35.

As per the telephone conversation with Examiner Justin Seo and Attorney Douglas M. Owens III, the indication of “a system for remotely programming a vehicle control system”, as stated in the grouping above, is merely a typographical error, and should read “a process”.

Applicants respectfully traverse the election requirement imposed in the Office action, but provisionally elect Group I, containing Claims 21-31, classified in class 347, subclass 2.

More specifically, Applicants object to and traverse the election requirement on the grounds that the subject matter of the two Groups is distinct. In issuing the Restriction Requirement, the Examiner asserts that Inventions of Groups I and II are distinct because the process of Invention (II) can be practiced by hand. However, Claims 32-38 are directed to a method of operation of an apparatus as recited in Claims 21-32, and therefore, not directed to a process that can be practiced by a materially different apparatus or by hand. Additionally, Applicants have further amended Claims 32 and 35-37 to clarify that Claims 32-38 are directed to a method of operation of an apparatus similar to that recited in Claims 21-32, not an operation

capable of being performed by hand. Accordingly, it is respectfully submitted that all pending claims, i.e., Claims 21-38, are directed to a single invention, and are therefore, examinable as a whole.

Additionally, even if the Examiner does not find the above argument and amendments persuasive, it is respectfully submitted that the Examiner should examine Claims 21-38 as a whole, as doing so would not be a serious burden on the Examiner. Although the Examiner has presented a list of possible reasons that a serious burden may apply (pages 2-3 of the Office Action), the Examiner has failed show how any of the reason occur in the present case or how the Examiner is faced with a serious burden.

As specifically stated in MPEP §803, in imposing a restriction requirement, the Examiner must show that:

- (A) the inventions are independent (*see* MPEP §802.01, §806.04, §808.01) or distinct as claimed (*see* MPEP §806.05 - §806.05(i)); **and**
- (B) there will be a **serious burden** on the Examiner if the restriction requirement is not imposed (*see* MPEP §803.02, §806.04(a) -§806.04(i),§808.01(a), and §808.02). It is respectfully submitted that there would **not be a serious burden** upon the Examiner in searching Groups I and II.

Additionally, Applicants object to and traverse the restriction requirement on the grounds that the subject matter of the two groups overlap and must be simultaneously examined in compliance with 37 CFR §1.104(a). In addition, the mandatory fields of search for the two embodiments are coextensive. Finally, it appears that the restriction requirement is being imposed merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions by the Commissioner.

A search of the U.S. Patent Collection produced the following partial list of recent U.S. Patent issues, which are in fact classified in both class 347 and class 101:

Searching US Patent Collection...

Results of Search in US Patent Collection db for:

(CCL/347/\$ AND CCL/101/\$): 865 patents.

Hits 1 through 50 out of 865

PAT. NO.	Title
1	<u>7,444,935</u> T <u>Method for correction of variations in the amount of ink applied in a printing process</u>
2	<u>7,430,961</u> T <u>Method of and system for forming image and an expendable</u>
3	<u>7,415,928</u> T <u>Printing machines with at least one color support</u>
4	<u>7,413,301</u> T <u>Inkjet printing apparatus with multiple platens</u>
5	<u>7,411,164</u> T <u>Device for inductive injection of thermal energy into a printing form for fixing an image</u>
6	<u>7,410,314</u> T <u>Apparatus for receiving inverting and returning sheets from and to a printer for large-sized paper</u>
7	<u>7,394,564</u> T <u>Printing machine with a control unit that displays a plurality of key operation switches to control ink keys</u>
8	<u>7,390,133</u> T <u>Duplex printer including print unit shifting and web shifting mechanisms</u>
9	<u>7,390,084</u> T <u>Ink jet printer having multiple transfixing modes</u>
10	<u>7,363,859</u> T <u>Temperature detecting unit with fixing apparatus</u>
11	<u>7,361,285</u> T <u>Method for fabricating cliché and method for forming pattern using the same</u>
12	<u>7,344,324</u> T <u>Image forming apparatus having a member for pressing a print head element against a platen roller</u>
13	<u>7,341,339</u> T <u>Tray transferring controller, recording apparatus and liquid ejecting apparatus</u>

14	<u>7,302,888</u>	T	<u>Method and apparatus for rotational media printing</u>
15	<u>7,290,489</u>	T	<u>Substrate inspecting apparatus and control method thereof</u>
16	<u>7,284,925</u>	T	<u>Printer module for a printing array</u>
17	<u>7,284,485</u>	T	<u>Alignment elements for an apparatus for handling printing plates</u>
18	<u>7,279,695</u>	T	<u>Edge position detecting apparatus and method, and program</u>
19	<u>7,261,477</u>	T	<u>Method of on-demand printing</u>
20	<u>7,258,067</u>	T	<u>Drying equipment for high speed printer</u>
21	<u>7,255,422</u>	T	<u>Franking machine</u>
22	<u>7,252,448</u>	T	<u>Platen</u>
23	<u>7,237,890</u>	T	<u>Inkjet printing apparatus</u>
24	<u>7,226,225</u>	T	<u>Printing apparatus, printing method, and program</u>
25	<u>7,210,407</u>	T	<u>Wallpaper printing franchise method</u>
26	<u>7,207,269</u>	T	<u>Coating material applying method and coating material applying apparatus for applying a coating material to surfaces of prints, and a printing machine having the coating material applying apparatus</u>
27	<u>7,194,958</u>	T	<u>Printed cloth</u>
28	<u>7,176,649</u>	T	<u>DC motor control apparatus and recording apparatus</u>
29	<u>7,175,354</u>	T	<u>Inkjet printing device</u>
30	<u>7,168,870</u>	T	<u>Thermal activation method and processing method for heat-sensitive adhesive sheet, and thermal activation device and printer for heat-sensitive adhesive sheet</u>
31	<u>7,168,365</u>	T	<u>Transfer of image with sublimating inks and medium in sheet form for performing it</u>
32	<u>7,159,517</u>	T	<u>Method of marking or lettering metallic components</u>
33	<u>7,152,049</u>	T	<u>Method and system for dispensing virtual stamps</u>
34	<u>7,146,910</u>	T	<u>Method for fabricating pattern, apparatus for fabricating pattern, conductive film wiring, method for fabricating device, electro-optical apparatus, and electronic apparatus</u>

35	<u>7,137,698</u>	T	<u>Recording apparatus and liquid ejection apparatus</u>
36	<u>7,131,372</u>	T	<u>Miniature fluid dispensing end-effector for geometrically constrained areas</u>
37	<u>7,126,146</u>	T	<u>Device and method for detecting the edge of a recording material</u>
38	<u>7,121,209</u>	T	<u>Digital semiconductor based printing system and method</u>
39	<u>7,121,203</u>	T	<u>Apparatus and method of treating a recording element</u>
40	<u>7,121,202</u>	T	<u>Imaging apparatus and imaging method to increase efficiency of mounting/demounting of a recording material to/from a recording drum</u>
41	<u>7,119,820</u>	T	<u>Scanning heads</u>
42	<u>7,104,712</u>	T	<u>Roll sheet holder and tape printer</u>
43	<u>7,104,216</u>	T	<u>Coating liquid application apparatus for ink-printed medium and image printing apparatus having same</u>
44	<u>7,101,037</u>	T	<u>Image recording device</u>
45	<u>7,100,508</u>	T	<u>Color registration test pattern</u>
46	<u>7,097,269</u>	T	<u>Proofing head and proofer printer apparatus</u>
47	<u>7,086,729</u>	T	<u>Tray transferring controller, recording apparatus and liquid ejecting apparatus</u>
48	<u>7,080,901</u>	T	<u>Printing unit and manufacturing line for manufacturing flexible organic EL display</u>
49	<u>7,078,875</u>	T	<u>DC motor control apparatus and recording apparatus</u>
50	<u>7,073,443</u>	T	<u>Method for preparing proof for plate printing, and recording medium</u>

Further, a search of the U.S. Patent Collection produced the following list of recent U.S. Patent issues, which are in fact classified in both class 347, subclass 2, and class 101, subclass 35:

Searching US Patent Collection...

Results of Search in US Patent Collection db for:
(CCL/347/2 AND CCL/101/35): 10 patents.

Hits 1 through 10 out of 10

PAT. NO.	Title
1	<u>6,923,115</u> T <u>Method, apparatus and system for printing on textured, nonplanar objects</u>
2	<u>6,360,044</u> T <u>Optical article printing for controlled attenuation</u>
3	<u>5,160,940</u> T <u>Ink-jet printing device for straws to contain biological fluids</u>
4	<u>5,121,133</u> T <u>Marking method showing a sequence of side-by-side conductors in series for information purposes</u>
5	<u>5,119,109</u> T <u>Method and apparatus for marking the inside surface of pipe</u>
6	<u>5,113,757</u> T <u>Method and apparatus for making printed elastic bands</u>
7	<u>4,682,182</u> T <u>Marking device for pipe</u>
8	<u>4,665,600</u> T <u>Automatic device for processing a product</u>
9	<u>4,168,662</u> T <u>Videojet ink for printing on food products</u>
10	<u>4,146,900</u> T <u>Printing system</u>

The foregoing listings of art included within all Groups I-II demonstrates all the lack of burden upon the Examining staff in making a simultaneous search of Groups I-II and the absence of evidence that Groups I-II are distinct.

Firstly, the Examiner has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner must examine the application on the merits, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the Office Action and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement cannot be made final according to MPEP §706.07.

Secondly, whereas the Examiner has stated that the invention of Group I including Claims 21-31 drawn to an apparatus, classified in class 347, subclass 2; and Group II including Claims 32-38, drawn to a process, classified in class 101, subclass 35, it is respectfully submitted that, in order to perform a comprehensive search, the Examiner is going to be compelled to perform some searching in both classes 347 and 101.

The foregoing listing of art included within all Groups I-II demonstrates all the utter lack of burden upon the Examining staff in making a simultaneous search of Groups I-II and the absence of evidence that Groups I-II are distinct. Moreover, the overwhelming evidence in the administrative record is convincing evidence of the absence of any burden because the mandatory fields of search overlap. It is submitted therefore, that Applicants' foregoing listing of a search of the U.S. Patent Collection produced the above-repeated partial list of recent U.S. Patents issued, which are in fact classified in both class 347 and 101. Thus, under long standing Office practice extending over approximately three decades, the fields of search are coextensive with respect to the two groups of claims, and therefore the restriction requirement serves no

purpose other than to impose an undue burden and unnecessary expense upon the Applicants (*see* MPEP §802.01, §806.04, §808.01).

Thirdly, *MPEP* §806.03 states that:

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition (emphasis supplied).

This raises the question as to why this prohibition has been violated in the above-captioned application where a single embodiment has been disclosed. That fact that Applicants' claims are broad in scope, and cover a plethora of implementations of the principles of Applicants' inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

For the above reasons, it is respectfully submitted that the restriction requirement is unnecessary, is not in accordance with the Rules of Practice or the *Manual of Patent Examining Procedure*, and imposes of an undue burden and unfair expense upon the Applicants. Therefore, it is respectfully requested that the election requirement be withdrawn.

In view of the foregoing, it is requested that the election requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

Accordingly, all of the claims pending in the Application, namely, Claims 21-38, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,



Paul J. Farrell
Reg. No. 33,494
Attorney for Applicant

THE FARRELL LAW FIRM, PC
290 Broadhollow Road., STE 210E
Melville, NY 11747
Tel: (516) 228-3565
Fax: (516) 228-8475